

Amendments to the Drawings:

The attached sheets of drawings include changes to Figs. 2, 3, and 4. These sheets which include Figs. 1-4, replaces the original sheets including Figs. 1-4. In Figs. 2, 3, and 4, reference symbol "15" was added to indicate the optoelectronic component.

Please approve the drawing changes that are marked in red on the accompanying "Annotated Sheet Showing Changes" of Figs. 2, 3, and 4. Formal "Replacement Sheets" of amended Figs. 2, 3, and 4 are also enclosed.

Attachments: Replacement Sheets
Annotated Sheets Showing Changes

REMARKS

The present Amendment is in response to the Examiner's Final Office Action mailed August 9, 2005. Claim 14 was previously cancelled, claims 1, 8 and 13 are amended. Claims 1-13 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. Amended Drawings

In the first paragraph on page 2 of the above-identified Office action, the drawings have been objected to under 37 CFR 1.83(a).

The Examiner has stated that the electrical component/transceiver must be shown or the feature cancelled from the claim. Figs. 2, 3, and 4 have been changed to include the reference numeral "15" directed to the optoelectronic component. Furthermore, the specification was amended to include the reference numeral "15". Therefore, the objection to the drawings by the Examiner is believed to have been overcome.

Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

II. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. § 103

In the first paragraph on page 3 of the Office action, claims 1, 3-5, and 8-13 have been rejected as being anticipated by Waldron (U.S. Patent No. 3,530,479) in view of Applicants' Admitted Prior Art under 35 U.S.C. § 103. It is believed that the Examiner should have stated that the claims are obvious over the references and not anticipated by them.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found on page 7, lines 21-24 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

an optoelectronic component.

On page 1 of the specification of the instant application it is disclosed that optoelectronic transceivers with housing-shaped shielding plates are known from the prior art.

The Waldron reference discloses slotted wave guide aerials. A person of ordinary skill in the art would not consider the Waldron reference as pertinent prior art because it discloses wave guide aerials, which is a different technical field than that of the present invention. Waldron discloses microwave aerials, which represent a part of a radio transmitting or receiving system, which belong to the technical field of microwave antennas or radio systems. This is contrary to the present invention, which belongs to the technical field of electromagnetic shielding with application to optoelectronic components.

A person of ordinary skill in the art trying to improve shielding plates for optoelectronic components would consider prior art related to shielding elements or optoelectronic components. However, a person of ordinary skill in the art would not consider using teaching from microwave antennas or radio systems. Accordingly, a person of ordinary skill in the art would not consider the antenna element disclosed in Waldron when trying to improve shielding elements for optoelectronic transceivers. Therefore, there is no motivation for a person of ordinary skill in the art to combine Waldron with applicants' admitted prior art.

Moreover, A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on

general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

In the fifth paragraph on page 4 of the Office action, claims 2 and 6 have been rejected as being obvious over Waldron (U.S. Patent No. 3,530,479) in view of Kurtz (U.S. Patent No. 5,087,921) under 35 U.S.C. § 103. Kurtz does not make up for the deficiencies of Waldron. Since claim 1 is believed to be allowable, dependent claims 2 and 6 are believed to be allowable as well.

In the second paragraph on page 5 of the Office action, claim 7 has been rejected as being obvious over Waldron (U.S. Patent No. 3,530,479) in view of Glabe et al. (U.S. Patent No. 5,748,152) (hereinafter “Glabe”) under 35 U.S.C. § 103. Glabe does not make up for the deficiencies of Waldron. Since claim 1 is believed to be allowable, dependent claim 7 is believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 29 day of August, 2006.

Respectfully submitted,



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Annotated Sheet Showing Changes

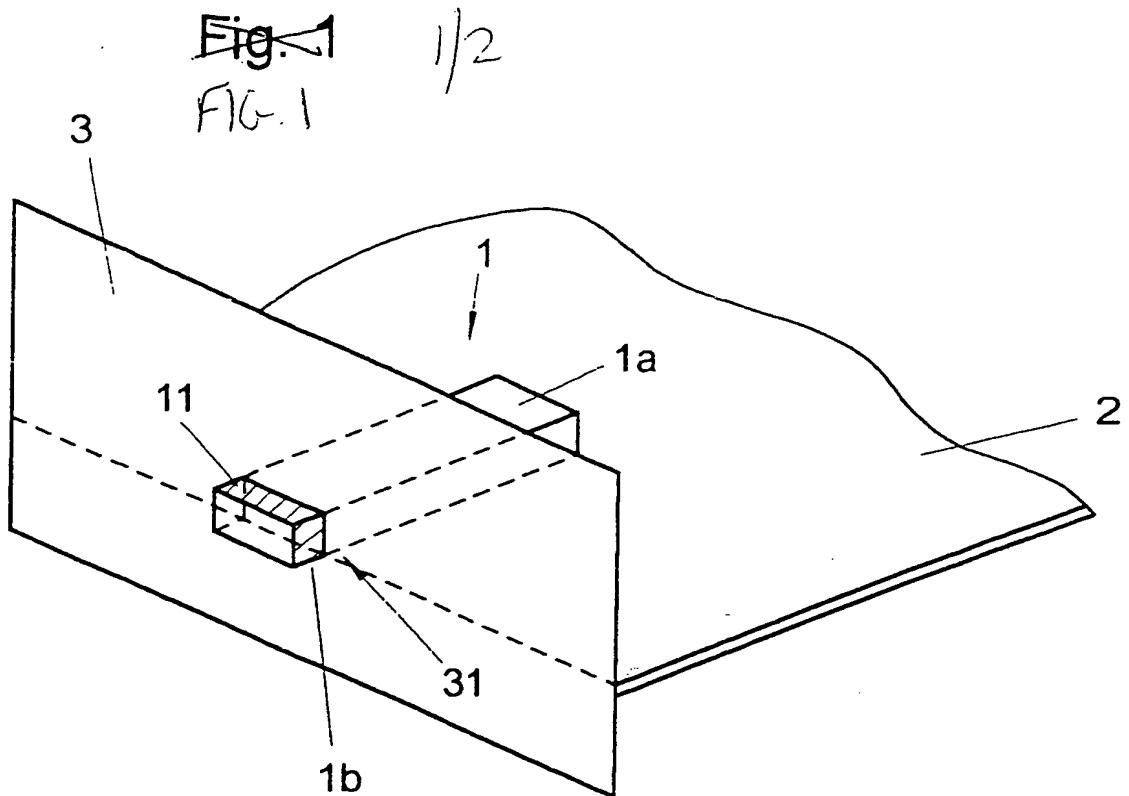
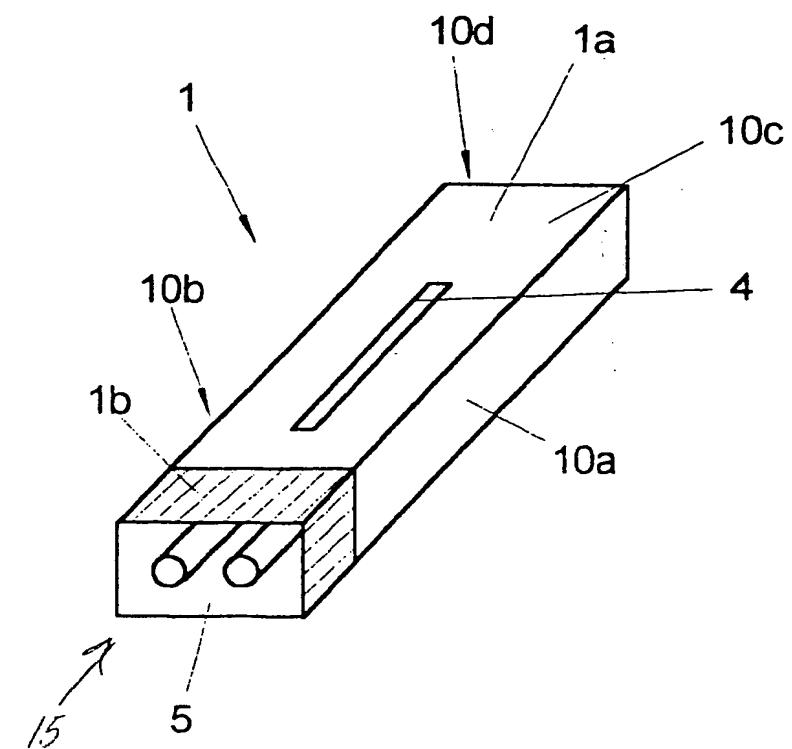


FIG. 2

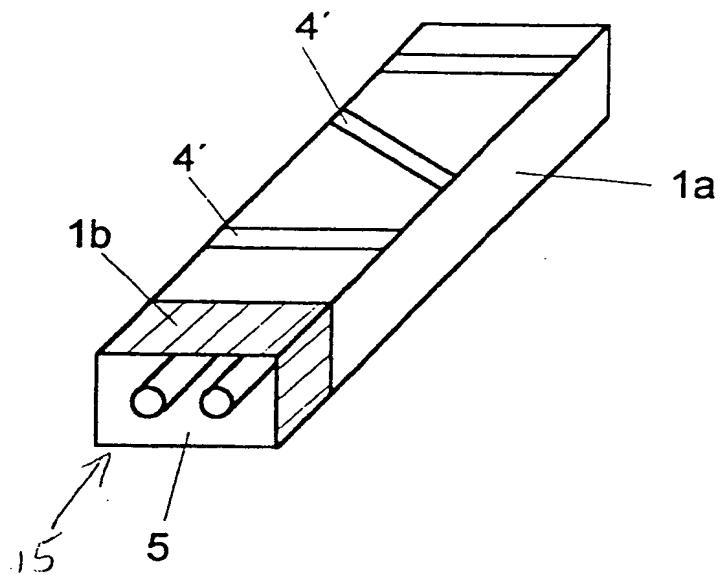
~~Fig. 2~~



Annotated Sheet Showing Changes

2/2

~~Fig. 3~~
FIG. 3



~~Fig. 4~~
FIG. 4

